

ESTTA Tracking number: **ESTTA16958**

Filing date: **10/13/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nine West Development Corporation
Granted to Date of previous extension	10/13/2004
Address	Nine West Development Corporation 200 West 9th Street Plaza Wilmington, DE 19801 UNITED STATES
Relationship to party who filed Extension of time to oppose	The word "Corporation" was misspelled as "Cprporation". The change is merely a spelling correction.

Attorney information	Jennifer Shmulewitz Nine West Footwear Corporation 1129 Westchester Avenue White Plains, NY 10604 UNITED STATES jshmulewitz@jny.com Phone:914 640-6423
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Applicant Information

Application No	76557010	Publication date	06/15/2004
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Opposition Filing Date	10/13/2004	Opposition Period Ends	10/13/2004
Applicant	Only Nine Apparel, LLC		

Goods/Services Affected by Opposition

Class 025.

All goods and services in the class are opposed, namely: Clothing, namely, shirts, T-shirts, under shirts, polo shirts, athletic uniforms, pants, trousers, slacks, jeans, denim jeans, overalls, jump suits, shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, blouses, skirts, dresses, sweaters, vests, jackets, denim jackets, reversible jackets, blazers, suits, turtlenecks, scarves, loungewear, sarongs, and body suits

Applicant Information

Application No	76557011	Publication date	06/15/2004
Opposition Filing Date	10/13/2004	Opposition Period Ends	
Applicant	Only Nine Apparel, LLC		

Goods/Services Affected by Opposition

Class 025.

All goods and services in the class are opposed, namely: Clothing, namely, shirts, T-shirts, under shirts, polo shirts, athletic uniforms, pants, trousers, slacks, jeans, denim jeans, overalls, jump suits, shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, blouses, skirts, dresses, sweaters, vests, jackets, denim jackets, reversible jackets, blazers, suits, turtlenecks, scarves, loungewear, sarongs, and body suits

Attachments	STUDIO 9 Notice of Opposition (Version2).txt (4 pages) NINE WEST STUDIO.txt (1 page) 78418331.txt (2 pages) 78418355.txt (2 pages) 78418369.txt (2 pages)
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Signature	/jennifer shmulewitz/
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Name	Jennifer Shmulewitz
Date	10/13/2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial Nos. 76/557,010 and 76/557,011
Published in the Official Gazette on June 15, 2004
Marks: STUDIO NINE and STUDIO 9

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 Nine West Development Corporation,)
)
 Opposer,)
)
 v.)
)
 Only Nine Apparel, LLC,)
)
 on No. _____)
 Applicant.)
)
 _____)

NOTICE OF OPPOSITION

Opposer Nine West Development Corporation ("Opposer" or "Nine West")

believes that it will be damaged by registration of the marks STUDIO NINE and STUDIO 9, shown in Application Serial Nos. 76/557,010 and 76/557,011, by applicant Only Nine Apparel, LLC ("Applicant"), and hereby opposes the same on the following grounds:

1. Nine West is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 200 West 9th Street Plaza, Wilmington, Delaware 19801.
2. Nine West, through its parent and related companies and licensees, is one of the leading designers, manufacturers and marketers of fashionable women's footwear, clothing, and accessories.
3. Nine West is the owner of the renowned NINE WEST trademark, which is federally registered and represents one of the most popular and famous brands in the world.
4. Nine West owns several registrations in the United States for the NINE WEST trademark, including the following:
 - * Reg. No. 1,775,652 for handbags, shoes, retail store services for handbags and shoes
 - * Reg. No. 2,518,612 for wearing apparel for women namely, leather, knit and woven dresses, coats, suits, jackets, blouses, shirts, sweaters, t-shirts tank-tops, camisoles, cardigans, pullovers, vests, pants, shorts, jeans, skirts, scarves and hats;
 - * Reg. No. 2,272,307 for clothing, namely, jackets, leather coats and rainwear;
 - * Reg. No. 2,246,350 for sunglasses, non-prescription reading glasses, clip-on sunglasses, eyeglass cases, eyeglass cords and sunglass cords;
 - * Reg. No. 2,198,938 for jewelry;
 - * Reg. No. 1,685,412 for shoes;
 - * Reg. No. 2,133,086 for sunglasses and hosiery;
 - * Reg. No. 2,322,474 for watches; and
 - * Reg. No. 2,571,795 for waterproofing chemical compounds for articles

of leather; cleaning solvents, lotions and cream for footwear, and shoe and boot polish; shoe brushes and polishing cloths for applying solvents to be used as a scuff remover.

(collectively, the "NINE WEST Mark").

5. Nine West also owns several federal registrations for 9 WEST and marks that incorporate "9" or "NINE," "9" and "NINE," which it sometimes uses interchangeably, including 9 WEST (Reg. No. 1,170,312) in Class 25; 9 NINE WEST (Reg. No. 2,775,692) in Class 25; 9 NINE WEST (Reg. No. 2,786,445) in Class 18; NINE & COMPANY (Reg. No. 2,675,669) in Class 25; NINE & COMPANY (Reg. No. 2,748,784) in Class 9; NINE & COMPANY (Reg. No. 2,760,248) in Class 18; NINE & COMPANY (Reg. No. 2,765,670) in Class 25; NINE & COMPANY (Reg. No. 2,619,058) in Class 25; NINE & COMPANY (Reg. No. 2,728,246) in Class 25; NINE & COMPANY (Reg. No. 2,745,259) in Class 25; NINE & COMPANY (Reg. No. 2,626,723) in Class 14; 9 & CO. (Reg. No. 1,933,092) in Class 18; 9 & CO. (Reg. No. 1,724,670) in Class 25; and 9 & CO. (Reg. No. 1,881,665) in Class 35.

6. For more than twenty years, Nine West, directly and through its predecessors in interest and licenses, has been using the federally registered marks NINE WEST and 9 WEST.

7. Nine West also owns the federally registered marks 9 & CO. and NINE COMPANY. Nine West's rights in 9 & CO. have priority dating back as early as 1990, and its rights in NINE & COMPANY have priority dating back as early as 2001.

8. NINE WEST is a total lifestyle brand outfitting consumers from head to toe with footwear, accessories, sportswear, dresses, jewelry, sunglasses, legwear, outerwear, watches, belts, eyewear, cold weather accessories and hats.

9. In or about 2002, Nine West introduced a special collection of goods under the mark NINE WEST STUDIO.

10. Nine West is the owner of U.S. Registration No. 2,856,725 for the mark NINE WEST STUDIO for footwear in International Class 25. A true and correct copy of the registration certificate is annexed hereto as Exhibit A.

11. Nine West also owns the following federal trademark applications, all of which have been published or approved for publication (together with the above-referenced registration, the "NINE WEST STUDIO Marks"):

Mark

Serial No.

Goods/Services

NINE WEST STUDIO

78/418,331

Handbags, purses, totebags; small leather goods, namely clutch purses, leather key cases, credit card cases, cosmetic cases sold empty, change purses, wallets, business card cases and passport cases

NINE WEST STUDIO

78/418,369

Jewelry

NINE WEST STUDIO

78/418,355

Clothing, namely, dresses, skirts, pants, shorts, tops, shirts, blouses, sweaters, jackets and vests

12. A copy of the USPTO Trademark Application and Registration Retrieval System records for the aforementioned applications is annexed hereto as Exhibit B.

13. Nine West's rights in the NINE WEST STUDIO Marks in the United States have priority since at least as early as January 24, 2002, long prior to the September 23, 2003 filing date of the subject intent-to-use applications.

14. Nine West continuously has used and currently is using the NINE WEST STUDIO Marks in the United States on or in connection with footwear since at least as early as May 2002. Nine West also has used the NINE WEST STUDIO Marks on handbags.

15. Nine West has exercised great care, skill, and diligence in providing footwear and accessories in connection with its NINE WEST STUDIO Marks. As a result, Opposer has developed substantial consumer recognition and valuable goodwill in its NINE WEST STUDIO Marks.

16. On information and belief, Applicant is a New York limited liability company having a place of business at 1407 Broadway, Suite 1101, New York, NY 10018. On further information and belief, Applicant's attorney of record is Teresa A. Lee, Pryor Cashman Sherman & Flynn LLP, 410 Park Avenue, New York, NY 10022.

17. On September 22, 2003, Applicant filed the intent-to-use applications at issue herein, Serial Nos. 76/557,010 and 76/557,011 (collectively, the "Applications"), seeking to register the marks STUDIO NINE and STUDIO 9 respectively in Class 25 for "[c]lothing, namely, shirts, T-shirts, under shirts, polo shirts, athletic uniforms, pants, trousers, slacks, jeans, denim jeans, overalls, jump suits, shorts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, blouses, skirts, dresses, sweaters, vests, jackets, denim jackets, reversible jackets, blazers, suits, turtlenecks, scarves, loungewear, sarongs, and body suits."

18. Applicant's STUDIO NINE and STUDIO 9 marks so closely resemble Nine West's NINE WEST STUDIO Marks as to be likely, when applied to Applicant's goods, to cause confusion or mistake or to deceive the trade and public, who are likely to believe that Applicant's goods have their origin with Nine West and/or that such goods are approved, endorsed, or sponsored by or associated with Opposer.

19. Because of the similarity of the marks and the related nature of the goods of the respective parties, Applicant's use of STUDIO NINE and STUDIO 9 for the aforementioned goods likely will result in consumer confusion as to source, affiliation, connection or association with Nine West. As such, Applicant's marks are not entitled to registration pursuant to 15 U.S.C. ? 1052(d).

20. Nine West believes it will be damaged by the registrations sought herein by Applicant's proposed marks within the meaning of 15 U.S.C. ? 1063(a).

21. This opposition is timely filed. Nine West received extensions to file an opposition against each application through and including October 13, 2004.

This Notice of Opposition is being filed in duplicate, along with a filing fee of \$600.00. Please address all communications to Jennifer Shmulewitz, Esq. at the address listed below.

WHEREFORE, Nine West requests that the registrations sought by Applicant be refused, that the Notice of Opposition be sustained, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: October 13, 2004

Respectfully submitted,

NINE WEST DEVELOPMENT CORPORATION

By: /ira m. dansky/

Ira M. Dansky

General Counsel

Please address all correspondence to:

Jennifer Shmulewitz

Assistant General Counsel

Nine West Footwear Corporation

1129 Westchester Avenue

White Plains, NY 10604

Phone: (914) 640-6423

Fax: (914) 640-1676

jshmulewitz@jny.com

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Int. CI.: 25
Prior U.S. CIs.: 22 and 39
Reg. No. 2,856,725
United States Patent and Trademark Office Registered June 22,2004
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.TRADEMARK
PRINCIP AL REGISTER
NINE WEST STUDIO
NINE WEST DEVELOPMENT CORPORATION OWNER OF U.S. REG. NOS. 1,685,412,
1,775,652,
(DELAWARE CORPORATION) AND ORNERS.
200 WEST 9TH STREET PLAZA
WILMINGTON DE 19801 NO CLAIM IS MADE TO THE EXCLUSIVE
, RIGHT TO USE "STUDIO", APART FROM THE
FOR: FOOTWEAR, IN CLASS 25 (u.s. CLS. 22 AND MARK AS SHOWN.
39). SN 78-104,621, FILED 1-24-2002.
FIRST USE 5-25-2002; IN COMMERCE 5-25-2002. ELLEN PERKINS, EXAMINING
ATTORNEY
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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-10-13 09:17:32 ET

Serial Number: 78418331

Registration Number: (NOT AVAILABLE)

Mark

(words only): NINE WEST STUDIO

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2004-09-07

Filing Date: 2004-05-13

The Information will be/was published in the Official Gazette on 2004-09-07

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:

CHHINA KARANENDRA S Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2004-07-26

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Nine West Development Corporation

Address:

Nine West Development Corporation

200 West 9th Street Plaza

Wilmington, DE 19801

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Phone Number: 212 642-3867

Fax Number: 212 921-5370

GOODS AND/OR SERVICES

International Class: 018

HANDBAGS, PURSES, TOTE BAGS; SMALL LEATHER GOODS, NAMELY CLUTCH PURSES, LEATHER KEY CASES, CREDIT CARD CASES, COSMETIC CASES SOLD EMPTY, CHANGE PURSES, WALLETS, BUSINESS CARD CASES and PASSPORT CASES

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

Disclaimer: "STUDIO"

Prior Registration Number(s):

1685412

1775652

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-09-07 - Published for opposition

2004-08-18 - Notice of publication

2004-06-28 - Approved for Pub - Principal Register (Initial exam)

2004-06-23 - Case file assigned to examining attorney

2004-05-21 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Nine West Development Corporation

200 West 9th Street Plaza

Wilmington, DE 19801

Phone Number: 212 642-3867

Fax Number: 212 921-5370

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-10-13 09:21:16 ET

Serial Number: 78418355

Registration Number: (NOT AVAILABLE)

Mark

(words only): NINE WEST STUDIO

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2004-10-12

Filing Date: 2004-05-13

The Information will be/was published in the Official Gazette on 2004-10-12

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:

CHHINA KARANENDRA S Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2004-09-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Nine West Development Corporation

Address:

Nine West Development Corporation

200 West 9th Street Plaza

Wilmington, DE 19801

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Phone Number: 212 642-3867

Fax Number: 212 921-5370

GOODS AND/OR SERVICES

International Class: 025

Clothing, namely, dresses, skirts, pants, shorts, tops, shirts, blouses, sweaters, jackets and vests

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

Disclaimer: "STUDIO"

Prior Registration Number(s):

1685412

1775652

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-10-12 - Published for opposition

2004-09-22 - Notice of publication

2004-08-13 - Law Office Publication Review Completed

2004-08-09 - Assigned To LIE

2004-06-28 - Approved for Pub - Principal Register (Initial exam)

2004-06-28 - Examiners amendment e-mailed

2004-06-23 - Case file assigned to examining attorney

2004-05-20 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Nine West Development Corporation

200 West 9th Street Plaza

Wilmington, DE 19801

Phone Number: 212 642-3867

Fax Number: 212 921-5370

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-10-13 09:20:13 ET

Serial Number: 78418369

Registration Number: (NOT AVAILABLE)

Mark

(words only): NINE WEST STUDIO

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2004-09-07

Filing Date: 2004-05-13

The Information will be/was published in the Official Gazette on 2004-09-07

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:

CHHINA KARANENDRA S Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2004-07-26

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Nine West Development Corporation

Address:

Nine West Development Corporation

200 West 9th Street Plaza

Wilmington, DE 19801

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Phone Number: 212 642-3867

Fax Number: 212 921-5370

GOODS AND/OR SERVICES

International Class: 014

Jewelry

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

Disclaimer: "STUDIO"

Prior Registration Number(s):

1685412

1775652

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-09-07 - Published for opposition

2004-08-18 - Notice of publication

2004-06-28 - Approved for Pub - Principal Register (Initial exam)

2004-06-23 - Case file assigned to examining attorney

2004-05-20 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Nine West Development Corporation

200 West 9th Street Plaza
Wilmington, DE 19801
Phone Number: 212 642-3867
Fax Number: 212 921-5370